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UNITED STATES DISTRICT COURT**NORTHERN DISTRICT OF CALIFORNIA****SAN FRANCISCO DIVISION**

20 THE REGENTS OF THE UNIVERSITY OF
 21 CALIFORNIA, a California corporation,

22 Plaintiff,

23 v.

24 ROGER JINTEH ARRIGO CHEN, an individual;
 25 GENIA TECHNOLOGIES, INC., a Delaware
 corporation; and DOES 1-25,

26 Defendants.

27 Case No. 3:16-cv-07396-EMC

**DEFENDANTS' NOTICE OF MOTION
AND MOTION TO JOIN OXFORD
NANOPORE TECHNOLOGIES, INC.**

Presiding: Hon. Edward M. Chen

Date: June 21, 2018

Time: 1:30 PM

Courtroom: Courtroom 5, 17th Floor

JURY TRIAL DEMANDED

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1 **NOTICE OF MOTION AND MOTION**

2 **TO: PLAINTIFF AND ITS ATTORNEYS OF RECORD**

3 **PLEASE TAKE NOTICE** that on June 21, 2018 at 1:30 PM, before the Honorable
4 Edward M. Chen, Defendants Roger Chen and Genia Technologies, Inc. (“Genia”) (collectively,
5 “Defendants”) will, and hereby do, move the Court to join Oxford Nanopore Technologies, Inc.
6 (“Oxford”) as a party-plaintiff pursuant to Fed. R. Civ. P. 19(a)(1). This Motion is supported by
7 the following Memorandum of Points and Authorities; the Declaration of Christopher R. Noyes,
8 and exhibits attached thereto; and such other written or oral argument as may be presented at or
9 before the time this motion is taken under submission by the Court.

10 **STATEMENT OF REQUESTED RELIEF**

11 Pursuant to Fed. R. Civ. P. 19(a)(1), Defendants request that the Court join Oxford as a
12 party-plaintiff in this action.

13 **STATEMENT OF ISSUE TO BE DECIDED**

14 Whether, pursuant to Fed. R. Civ. P. 19(a)(1), Oxford must be joined as a party-plaintiff
15 in this action.

16 **MEMORANDUM OF POINTS AND AUTHORITIES**

17 **I. INTRODUCTION**

18 For nearly one year, Defendants have pursued discovery on license agreements between
19 The University of California, Santa Cruz (“UCSC”) and Oxford in an effort to understand the
20 relationship between UCSC and Oxford, and Oxford’s role in this litigation. For months,
21 Plaintiff The Regents of the University of California (“UC”) would only produce a heavily
22 redacted version of UCSC’s license agreement with Oxford. Defendants were eventually able to
23 obtain a less redacted version of the license agreement on February 9, 2018. (*See Decl. Ex. A,*
24 *“Amended and Restated License Agreement,” Dec. 19, 2016, UCAL-00005105 (the “Amended*
25 *Agreement”).*) The Amended Agreement disclosed that [REDACTED]

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1 [REDACTED]
2 [REDACTED], which
3 were ultimately produced by UC on March 2, 2018. (Decl. Ex. B, UCAL-00116273, Ex. C,
4 UCAL-00116270.)
5 [REDACTED]
6 [REDACTED] Just ten days before
7 UC filed suit against Defendants, [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]

24 _____
25 ¹ U.S. Patent Application Nos. 14/056,636, 14/300,453, 14/919,315, 15/087,734, and
26 15/162,225; along with U.S. Patent Application Nos. 60/921,787, 60/931,115, 60/967,539,
32. ECF No. 48, FAC, ¶ 12/080,684, and International PCT Application No. PCT/US2008/004467.

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1 [REDACTED]

2 Additionally, Oxford previously filed its *own* patent applications claiming ownership of certain
3 of the claims and inventions in dispute here. As such, a determination of ownership in this case
4 that only resolves the dispute between UC and Defendants “cannot accord complete relief among
5 existing parties.” Fed. R. Civ. P. 19(a)(1).

6 Given Oxford’s [REDACTED] in the outcome of this dispute, and because
7 Defendants face a substantial risk of incurring double, multiple, or otherwise inconsistent
8 obligations because of Oxford’s interests, Oxford is a necessary party in this action under
9 Federal Rule of Civil Procedure 19(a)(1). Defendants respectfully submit to this Court that
10 Oxford therefore should be joined as a party-plaintiff.

11 **II. LEGAL STANDARD**

12 Pursuant to Federal Rule of Civil Procedure Rule 19(a)(1), a party that is “subject to
13 service of process and whose joinder will not deprive the court of subject-matter jurisdiction
14 must be joined as a party.” A party must be joined under Rule 19(a)(1)(A) if “in that person’s
15 absence, the court cannot accord complete relief among existing parties.” Alternatively, a party
16 must be joined under Rule 19(a)(1)(B) if that party “claims an interest relating to the subject of
17 the action and is so situated that disposing of the action in the person’s absence may: (i) as a
18 practical matter impair or impede the person’s ability to protect the interest; or (ii) leave an
19 existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent
20 obligations because of the interest.” If either of the above conditions are met, the Ninth Circuit
21 deems the party to be “necessary,” using the “the traditional terminology.” *Am. Greyhound*
22 *Racing, Inc. v. Hull*, 305 F.3d 1015, 1022 (9th Cir. 2002).

23 When “an absentee is a necessary party” then “the second stage is for the court to
24 determine whether it is feasible to order that the absentee be joined.” *E.E.O.C. v. Peabody W.*
25 *Coal Co.*, 400 F.3d 774, 779 (9th Cir. 2005). There are “three circumstances in which joinder is

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1 not feasible: when venue is improper, when the absentee is not subject to personal jurisdiction,
2 and when joinder would destroy subject matter jurisdiction.” *Id.*

3 As demonstrated below, Oxford is a necessary party that must be joined as a plaintiff
4 under Rule 19(a)(1), and joinder is feasible here.

5 **III. FACTUAL BACKGROUND**

6 **A. Plaintiff’s Lawsuit**

7 Plaintiff UC brought this action alleging that defendant Roger Chen, while a graduate
8 student at the UCSC, “conceived of and developed a series of inventions and proprietary
9 technologies relating to a computer chip containing an array of individually addressable
10 nanopores, which is used in characterizing a nucleic acid sequence of each of a plurality of
11 nucleic acid molecules (the ‘UCSC Inventions’).” (ECF No. 48, First Amended Complaint, ¶ 2.)
12 UC seeks injunctive relief and damages relating to the alleged UCSC Inventions, including,
13 among other things, assignment of certain patent rights, disgorgement of profits purportedly
14 attributable to those rights, and other monetary damages. (*See id.* at 45-46.)

15 Currently, UC is the sole named plaintiff. In its Certificate of Interested Parties, UC
16 disclosed that Oxford “has a financial interest in the subject matter in controversy as the
17 exclusive licensee of certain patent applications and patents involved in this dispute.” (ECF No.
18 4 at 2.) Until recently, however, the extent of Oxford’s interest in this dispute was unknown to
19 Defendants. After Defendants made repeated requests for Oxford’s exclusive license to the
20 patent applications and patents involved in this dispute, on February 9, 2018, UC produced a
21 sufficiently unredacted version of the “Amended and Restated License Agreement” between
22 Oxford Nanopore Technologies Limited and the Regents of the University of California (the
23 “Amended Agreement”). [REDACTED]

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1 [REDACTED]
2 [REDACTED]
3 **B. The UCSC/Oxford License Agreements**
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

² On April 14, 2017, Defendants served discovery requests seeking any license agreements between UCSC and Oxford. On November 29, 2017, Plaintiff produced a heavily redacted version of the Amended Agreement. The same day, Defendants notified Plaintiff that they intended to take steps to obtain the full agreement. Plaintiff produced the Amended Agreement for a second time on December 5, 2017; once again, it was heavily redacted. On January 3, 2018, Defendants again requested an unredacted copy of the Amended Agreement. On January 12, 2018, Plaintiff again produced a heavily redacted version. On February 6, 2018, Defendants requested an unredacted copy of the Amended Agreement for the third time. On February 9, 2018, Defendants finally received a far less redacted version of the Amended Agreement.

UC also alleges that certain Genia patents are “derived from the UCSC Inventions.” (ECF No. 48 ¶ 5; *id.* ¶ 57 (listing the “Genia Patents”).) According to UC, the Genia Patents “rightfully belong to the University” as the purported “true owner of the Genia Patents.” (ECF No. 48 ¶¶ 6-7.)

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1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED] 6 [REDACTED] [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25
26 [REDACTED] 4 [REDACTED]
27 [REDACTED]

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1 2 3 4
5 6 7 8
C. Oxford's Patent Applications

9 10 11 12
13 14 15 16
17 18 19 20
21 22 23 24
25 26 27 28
[REDACTED] , Oxford has filed patent applications and holds its own issued patents relating to DNA sequencing. Two of Oxford's patent applications directly copied claim language from Genia's U.S. Patent No. 8,461,854, which is one of the Genia patents plaintiff UC claims to rightfully own. (Decl. Ex. D, U.S. Patent Application No. 14/302,287, Ex. E, U.S. Patent Application No. 14/302,303.)⁶ The Oxford patent applications name different inventors than the University Patent Applications and the Genia Patents. (*Id.*) Oxford's separate claim to ownership of the same technology in dispute in this case is not presently part of this case.

IV. ARGUMENT

A. Oxford Is a Necessary Party Under Fed. R. Civ. P. 19(a)(1)

When "conducting the Rule 19(a)(1) analysis," the inquiry is "whether the absence of the party would preclude the district court from fashioning meaningful relief as between the parties." *Cuevas v. Joint Benefit Tr.*, No. 13-CV-00045-JST, 2013 WL 3578496, at *2 (N.D. Cal. July 12,

[REDACTED]
5 [REDACTED], UC did not join Oxford as a party to this action. (ECF No. 1, Dec. 29, 2016.) In August and October 2016, the PTO issued Office actions for U.S. Patent Application Nos. 14/302,287 and 14/302,303, to which Oxford did not respond. (Decl. Ex. F, Ex. G.) Accordingly, in 2017 the PTO issued notices of abandonment for U.S. Patent Application Nos. 14/302,287 and 14/302,303. (Decl. Ex. H, Ex. I.) While U.S. Patent Application Nos. 14/302,287 and 14/302,303 were abandoned, Oxford has recently filed new continuation patent applications that would allow Oxford to once again pursue these copied claims. (Decl. Ex. J (U.S. Patent Application No. 15/434,574, continuation of U.S. Patent Application No. 14/302,287); Ex. K (U.S. Patent Application No. 15/491,450, continuation of U.S. Patent Application No. 14/302,303).)

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1 2013) (quotations omitted). “This factor is concerned with consummate rather than partial or
2 hollow relief as to those already parties, and with precluding multiple lawsuits on the same cause
3 of action.” *Id.* The Court’s inquiry is “guided by pragmatic considerations,” including whether a
4 licensee has “a sufficient interest … as could … subject [Defendants] to multiple liability.” *Katz*
5 *v. Lear Siegler, Inc.*, 909 F.2d 1459, 1462 (Fed. Cir. 1990) (quotations omitted); *see also id.*
6 (“joinder of claims, parties and remedies is strongly encouraged”) (quoting *United Mine Workers*
7 *v. Gibbs*, 383 U.S. 715, 724 (1966)). Notably, the less redacted Amended Agreement was
8 important for Defendants to obtain prior to moving to join Oxford in part because [REDACTED]

9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]

15 **1. Joining Oxford Is Necessary Under Rule 19(a)(1)(A) To Accord
16 Complete Relief to the Existing Parties**

17 To fashion meaningful relief for the existing parties in this patent ownership dispute,
18 Oxford must be joined. A determination of ownership without Oxford’s participation will result
19 in incomplete relief because (1) [REDACTED]
20 [REDACTED]
21 [REDACTED]; and (3) Oxford has independently filed (without UCSC) patent
22 applications asserting ownership of the same claims at issue here.
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]

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1 [REDACTED]
2 [REDACTED]
3 [REDACTED] . See, e.g.,
4 *SonoSim, Inc. v. Medaphor Ltd.*, No. CV 16-2847-GW, 2016 WL 7479363, at *2-3 (C.D. Cal.
5 Oct. 17, 2016) (holding that an exclusive licensee had standing to sue despite [REDACTED])

6 [REDACTED]
7 [REDACTED]
8 [REDACTED] To alleviate that threat and to accord complete
9 relief, Oxford must be joined. *See Superguide Corp. v. DirectTV Enters., Inc.*, 202 F.R.D. 460,
10 463 (W.D.N.C. 2001) (“The court finds that joinder of [the exclusive licensee] is necessary to
11 afford complete relief among the parties.”).

12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED] Joining
18 Oxford in this action will allow complete and meaningful resolution of [REDACTED] ownership
19 claims arising out of the facts and circumstances that led to this litigation. Oxford’s non-joinder,
20 on the other hand, “creates a genuine risk of multiple adjudications on the same issues and
21 creates real doubt that this court’s judgment will accord the parties the relief to which they are
22 ultimately entitled.” *Gould v. Control Laser Corp.*, 462 F. Supp. 685, 687 (M.D. Fla. 1978),
23 *aff’d in part and appeal otherwise dismissed*, 650 F.2d 617 (5th Cir. 1981); *see also Cuevas*, No.
24 13-CV-00045-JST, 2013 WL 3578496, at *2.

25 In patent cases, “[i]t is well settled that ‘[f]or the same policy reasons that a patentee must
26 be joined in any lawsuit involving his or her patent, there must be joinder of any exclusive

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1 licensee.”” *IRIS Corp. Berhad v. United States*, 82 Fed. Cl. 488, 499 (Fed. Cl. 2008) (quoting
2 *Aspex Eyewear, Inc. v. Miracle Optics, Inc.*, 434 F.3d 1336, 1344 (Fed. Cir. 2006)). In *Aspex*,
3 the Federal Circuit looked to longtime Supreme Court precedent asserting that “both the owner
4 [of a patent] and the exclusive licensee are generally necessary parties in an action in equity.”
5 434 F.3d at 1344 (citing *Indep’t. Wireless Tel. Co. v. Radio Corp. of Am.*, 269 U.S. 459, 466
6 (1926)). *Aspex* has been widely cited and followed. *See, e.g., Advanced Audio Devices, LLC v.*
7 *Bay Consumer, Inc.*, No. 10 C 7699, 2011 WL 6016242, at *3 (N.D. Ill. Dec. 2, 2011) (citing
8 *Aspex* and explaining that “[a]n exclusive licensee should be joined to a suit by the patentee”);
9 *Amgen*, 456 F. Supp. 2d at 283 (“Pursuant to *Aspex*, the Court rules that an exclusive licensee
10 must be joined in an infringement suit brought by the patent owner.”); 1 Annotated Patent Digest
11 § 9:50 (“not only does the exclusive licensee have the right to join a suit brought by the patentee,
12 the Federal Circuit has held that the exclusive licensee must be joined”).

13 The Federal Circuit’s decision in *Aspex* is persuasive authority here because the “public
14 policy in favor of preventing multiple lawsuits on the same patent against the same accused
15 infringer” extends to the ownership dispute central to this case. 434 F.3d at 1343; *see also Katz*,
16 909 F.2d at 1462 (where patent holder brought infringement suit, Federal Circuit affirmed
17 joinder of licensee, “agree[ing] with the district court that [determining exactly who owns the
18 patents] is facilitated by joinder”). [REDACTED]

19 [REDACTED]
20 [REDACTED]
21 [REDACTED] Because “the disposition of this suit” could “expose the
22 defendants to multiple lawsuits if [the exclusive licensee] is not joined,” Oxford should be joined
23 as a party-plaintiff. *IRIS*, 82 Fed. Cl. at 499.

24 Third, Oxford has filed its own patent applications (separate from UCSC) that are
25 implicated here. Some of Oxford’s patent applications copy language from U.S. Patent No.
26 8,461,854 (“Genia’s ’854 Patent”), one of the Genia Patents at issue in this litigation and to

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1 which UC claims ownership. (Decl. Ex. D, Ex. E.) To illustrate, Claim 1 of Genia's '854 Patent
2 includes the following claim language:

3 [A] chip comprising a plurality of individually addressable nanopores, an
4 individually addressable nanopore of said plurality of individually addressable
5 nanopores containing at least one nanopore formed in a membrane disposed adjacent
6 to an electrode, wherein each individually addressable nanopore is adapted to
detect a nucleic acid molecule or a portion thereof[.]

7 (Decl. Ex. L.) In this litigation, UC asserts that it is the rightful owner of this claimed invention:

8 Akeson, Deamer, Dunbar, Wilson, and, on information and belief, Chen, jointly
9 conceived of at least systems for sequencing nucleic acid ... as claimed in at least the
Genia '854 Patent ... :

10 (a) a chip comprising a plurality of individually addressable nanopores, an
11 individually addressable nanopore of said plurality of individually addressable
12 nanopores containing at least one nanopore formed in a membrane disposed
adjacent to an electrode, wherein each individually addressable nanopore is
adapted to aid in the detection of said nucleic acid molecule or a portion[.]

13 (ECF No. 48 ¶ 83(a).) However, Oxford has separately taken the position in the Patent Office
14 that it (not UC) is the owner of this claimed invention in its U.S. Patent Application Nos.
15 14/302,303 and 14/302,287, which read in relevant part:

16 [A] chip comprising a plurality of individually addressable nanopores, an individually
17 addressable nanopore of said plurality of individually addressable nanopores containing
18 at least one nanopore formed in a membrane disposed adjacent to an electrode, wherein
19 each individually addressable nanopore is adapted to detect a nucleic acid molecule or a
portion thereof[.]

20 (Decl. Ex. D, Ex. E.)

21 Clearly, "nearly identical claims raise a substantial inventorship question." *Leviton Mfg.*
22 *Co. v. Universal Sec. Instruments, Inc.*, 606 F.3d 1353, 1360 (Fed. Cir. 2010). Therefore,
23 Oxford must necessarily be joined as a party in this case. The Court cannot fully resolve the
24 existing parties' ownership dispute because Oxford, as a non-party, has previously claimed that it
25 is the rightful owner of the same inventions in dispute here. As such, a determination of
26

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1 ownership that only resolves the dispute between Plaintiff UC and the Defendants “cannot
2 accord complete relief among existing parties.” Fed. R. Civ. P. 19(a)(1).

3 Oxford not only has the means ([REDACTED])

4 [REDACTED] to pursue separate litigation against Defendants, Oxford
5 has the incentive (separate from UCSC) to do so as a commercial competitor to Genia in DNA
6 sequencing. Thus, failing to join Oxford could provide Oxford with a second bite at the apple
7 by, for example, [REDACTED] in the
8 event that Defendants prevail against UC. *See Gould*, 462 F. Supp. at 687 (“In the event that the
9 judgment is adverse to [the patentee] … [the exclusive licensee] might well feel free to relitigate
10 the issue in another forum.”). Where, as here, non-joinder “could subject [a party] to multiple
11 litigation,” then joinder is required in order to provide “complete relief.” *Walsh v. Centeio*, 692
12 F.2d 1239, 1243-44 (9th Cir. 1982).

13 **2. Oxford Is a Necessary Party Under Rule 19(a)(1)(B)**

14 Oxford also must be joined as a party pursuant to Rule 19(a)(1)(B). There is no question
15 that Oxford “claims an interest relating to the subject of the action.” “An exclusive licensee is
16 considered to have” a “legally protected interest in the patent.” *Propat Int’l Corp. v. Rpost, Inc.*,
17 473 F.3d 1187, 1193 (Fed. Cir. 2007); *see also IRIS*, 82 Fed. Cl. at 499 (granting motion to join
18 exclusive licensee as a party plaintiff; finding “[licensee] retains a significant interest in the
19 patent-in-suit[, based on] … a long-term exclusive license with a potentially substantial financial
20 stake in the patent-in-suit [and the potential for] … 30 percent of the proceeds of this litigation”).
21 Accordingly, as the exclusive licensee [REDACTED], Oxford indisputably
22 has an interest in this action. *See supra* III.B. Further, disposing of this action in Oxford’s
23 absence would (1) leave Defendants subject to a substantial risk of incurring multiple or
24 inconsistent obligations [REDACTED], and (2) could impair or impede Oxford’s
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1 ability to protect ownership interests [REDACTED] or its
2 own patent applications.

- 3 a. *If Oxford is not joined, Defendants face substantial risks of*
4 *incurring multiple or inconsistent obligations.*

5 “Rule 19 is intended” not only “to protect the absentee from prejudice,” but also “to
6 protect those made parties from harassment by successive suits, and to protect the courts from
7 being imposed upon by multiple litigation.” 7 Fed. Prac. & Proc. Civ. § 1609 (3d ed.). [REDACTED]

8 [REDACTED]
9 [REDACTED] *Gould*, 462 F. Supp. at 686. “There can
10 be little question but that, had it elected to do so,” [REDACTED] action
11 here. *Id.* at 687. Accordingly, “[s]ince [Oxford] is a ‘proper party’ with an [REDACTED]
12 [REDACTED], an order compelling [its] joinder would
13 work no unfairness to either” Oxford or Plaintiff. *Id.* That alone is basis enough to join Oxford.
14 See *id.* (“The considerations of finality, judicial economy and fairness which underpin Rule 19
15 demand under these circumstances that [the exclusive licensee] be brought into the litigation.”).
16

17 Further, for the reasons described above, [REDACTED]
18 [REDACTED]
19 [REDACTED] The absence of Oxford as a party in this case means that
20 “there can simply be no guarantee that defendants will not be exposed to the risk of multiple
21 adjudications or that a final, binding judgment deciding all the issues between the parties can be
22 entered by this court.” *Id.* at 688; cf. *Pit River Home & Agr. Co-op. Ass'n v. United States*, 30
23 F.3d 1088, 1098-1099 (9th Cir. 1994) (affirming dismissal of, *inter alia*, plaintiff’s ownership
24 claim based on failure to join tribal council in possession of land, deeming absentee tribal
25 [REDACTED]
26 [REDACTED]
27

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1 council a “necessary party to this action” because judgment would not bind the tribal council
2 from “assert[ing] its right to possess” the property).

3 b. *Not joining Oxford could impair or impede its ability to protect its*
4 *claimed interest.*

5 This dispute also implicates Oxford’s own rights and alleged ownership in the disputed
6 inventions; [REDACTED], “the interest [of the party that
7 Defendants seek to join] arises from terms in bargained contracts, and the interest is substantial.”
8 *Am. Greyhound Racing*, 305 F.3d at 1023. Plaintiff UC argues that the Genia Patents at issue in
9 this litigation were “derived from” the “UCSC Inventions,” which purportedly “rightfully belong
10 to the University.” (ECF No. 48 ¶¶ 5-6.) At the same time, UC claims that its own “University
11 Patent Applications” are also “based on the UCSC Inventions.” (*Id.* ¶ 3.) If Defendants prevail
12 here, that will implicate the purported UCSC Inventions and, by extension, [REDACTED]

13 [REDACTED]. *See IRIS*, 82 Fed. Cl. at 499 (“[T]he
14 disposition of [licensor’s] suit without [the exclusive licensee] could impair or impede [the
15 exclusive licensee’s] ability to protect his interests.”); *cf. Pit River Home*, 30 F.3d at 1098-1099
16 (tribal council, as possessor of disputed property, had “a legal interest in the litigation, which
17 would be impaired by the disposition of th[e] action without [the tribal council’s] presence”).
18 Therefore, “[a]djucation of plaintiff’s claim necessarily will adjudicate the [absent party’s]
19 right to enforce the contract it has negotiated”—a practical reality that supports joinder. *See*
20 *Greer v. Pac. Gas & Elec. Co.*, No. 1:15-CV-01066-EPG, 2016 WL 2939148, at *3 (E.D. Cal.
21 May 18, 2016).

22 Finally, as discussed above, the fact that both UCSC and Oxford have purported to be the
23 inventors of the same disputed claims means that any adjudication here implicates (without
24

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1 resolving) Oxford's interests. Oxford's "participation is necessary to protect its legally
2 cognizable interests [and] to protect other parties from a substantial risk of incurring multiple or
3 inconsistent obligations because of those interests." *Cuevas*, No. 13-CV-00045-JST, 2013 WL
4 3578496, at *2 (quotation omitted). As a result, Oxford should be joined.

5 **B. Joining Oxford Is Feasible**

6 It is feasible to join Oxford as a party in this action. This Court has subject-matter
7 jurisdiction unaffected by joinder of Oxford, venue is proper, and, as set forth below, Oxford is
8 unquestionably subject to personal jurisdiction.

9 **1. Oxford Is Subject to Personal Jurisdiction in This Forum**

10 Oxford is a corporation organized under the laws of Delaware and has its principal place
11 of business located at 1 Kendall Square, Cambridge, MA 02139. *Illumina, Inc. et al v. Oxford*
12 *Nanopore Technologies Ltd. et al*, 3:16-cv-00477 (S.D. Cal.), ECF No. 14 at 2 ("Consent Order,
13 Final Judgment, and Permanent Injunction"). "In deciding whether the Court has jurisdiction
14 over an out-of-state defendant, the Court looks to Federal Circuit precedent," which uses the
15 same test as the Ninth Circuit "when applying the minimum contacts standard set forth by the
16 Supreme Court." *Wistron Corp. v. Phillip M. Adams & Assocs., LLC*, No. C-10-4458 EMC,
17 2011 WL 1654466, at *3 (N.D. Cal. Apr. 28, 2011). "Because California's long-arm
18 jurisdictional statute is coextensive with the limits of due process, the two inquiries
19 [constitutional and statutory] collapse into a single inquiry: whether jurisdiction comports with
20 due process." *Id.* (quoting *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1360 (Fed. Cir. 2001)).
21 "The Court considers three factors in determining whether the exercise of specific personal
22 jurisdiction over an out-of-state defendant comports with due process: (1) whether the defendant
23 'purposefully directed' its activities at residents of the forum; (2) whether the claim 'arises out of
24 or relates to' the defendant's activities in the forum; and (3) whether the exercise of jurisdiction
25 is 'reasonable and fair.'" *Id.* at *4 (quoting *Deprenyl Animal Health, Inc. v. Univ. of Toronto*
26 *Innovations Found.*, 297 F.3d 1343, 1351 (Fed. Cir. 2002)).

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1 **2. Oxford Has Purposefully Directed Relevant Activities to Residents in**
2 **This Forum**

3 While discovery is ongoing,⁷ it is undisputed that Oxford holds an exclusive license
4 agreement with UCSC, a California institution. (ECF No. 4 at 2.) [REDACTED]

5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]

17 **3. UC's Claims Relate to Oxford's Contacts with California**

18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]

24 ⁷ Defendants' pending discovery requests include, *inter alia*, [REDACTED]
25 [REDACTED]; (2) communications between Oxford and the
26 alleged UCSC Inventors concerning Defendants; and (3) [REDACTED]
27 [REDACTED].

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1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED] There is no question that Oxford
15 has been [REDACTED]
16 [REDACTED] and other activities in this forum. Moreover, if UC were to prevail on its claim for
17 damages, [REDACTED]
18 [REDACTED]

19 **4. The Exercise of Personal Jurisdiction is Reasonable and Fair**

20 Oxford has directed relevant commercial activities at residents of California and has
21 engaged in negotiations and litigation with the California-based parties to this suit. [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]

26 [REDACTED] Considering Oxford's
27

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1 "extensive licensing and enforcement activities with California residents, it would not be unfair
2 to require [it] to litigate in this Court." *See Wistron*, No. C-10-4458 EMC, 2011 WL 1654466, at
3 *10. Moreover, Oxford previously waived service of a complaint in a patent infringement action
4 brought against Oxford in the Southern District of California. *Illumina, Inc. et al v. Oxford*
5 *Nanopore Technologies Ltd. et al*, 3:16-cv-00477 (S.D. Cal.), ECF No. 8 at 1. Oxford consented
6 to jurisdiction in that case, and the district court found that it had personal jurisdiction over
7 Oxford, and that venue was proper. *Id.* at ECF No. 14 at 1-2.

8 Finally, as a practical matter, discovery is ongoing in this matter and Oxford is already
9 involved, such that Oxford's joinder should not delay the trial date set in this matter.⁸ Oxford
10 made initial document productions on March 9 and March 26, 2018, in response to a Rule 45
11 subpoena.⁹ While Oxford has produced some documents, third-party discovery of Oxford is
12 insufficient and ultimately prejudicial to Defendants. For example, Oxford has repeatedly
13 objected to identifying and producing documents that are "in the possession of Plaintiff[]" while
14 at the same time Plaintiff has repeatedly objected to producing documents "that may be subject
15 to third party confidentiality obligations or restrictions." (Decl. Ex. O, Oxford's Responses &
16 Objections to Genia's Subpoena, Response to Request Nos. 1, 8, 14, 15; Decl. Ex. P, Plaintiff's
17 Responses to Defendants' First Set of Production Requests, Nos. 11, 25, 27, 28, 43, 53.) On
18 March 9, 2018, Plaintiff also added various search terms involving Oxford to the list Defendants
19 will apply to their collection of email electronically stored information ("ESI"), indicating
20 Plaintiff's acknowledgment of the importance of Oxford to this litigation. And, as described
21
22

23
24 ⁸ Separately, the Court has granted the parties' joint stipulation to extend fact discovery in this
litigation. ECF No. 85.

25 ⁹ [REDACTED]

26 These documents are relevant to Defendants'
27 statutes of limitations defense. ECF Nos. 73 at 17 and 74 at 17.

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1 above, UC and Oxford share the same outside counsel. Oxford's joinder would not represent a
2 hardship for the existing parties.

3 **V. CONCLUSION**

4 For the foregoing reasons, Defendants respectfully request that the Court join Oxford as a
5 party-plaintiff in this action.

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1 Dated: April 6, 2018.

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3 **WILMER CUTLER PICKERING**
4 **HALE AND DORR LLP**

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1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that a true and correct copy of the above and foregoing
3 document has been served on April 6, 2018, to all counsel of record who are deemed to have
4 consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.5. Any
5 other counsel of record will be served by electronic mail, facsimile, and/or overnight delivery.

6 */s/ Robert J. Gunther, Jr.* _____